UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,433	11/13/2000	Jeff Stewart	MIME-0003	4323

23550   7590   11/02/2011
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EXAMINER
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ART UNIT	PAPER NUMBER
2177	

NOTIFICATION DATE	DELIVERY MODE
11/02/2011	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
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Ex parte JEFF STEWART and JENNIFER R. PINCO
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Appeal 2011-011457
Application 09/709,433
Technology Center 2100
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Before LANCE LEONARD BARRY, ST. JOHN COURTENAY III, and
CAROLYN D. THOMAS, *Administrative Patent Judges.*

COURTENAY, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the
Examiner's rejection of claims 12-16, 20-27, and 31-43. Claims 1-11, 17-
19, and 28-30 have been cancelled (App. Br. 2). We have jurisdiction under
35 U.S.C. § 6(b).

We Affirm-in-part.

<center>THE INVENTION</center>

The disclosed invention relates generally to a system, method, and recordable medium for uploading data across a network. More particularly, Appellants' invention is directed to uploading a document across the network for printing services, and configuring, ordering, and viewing the document online (Spec. 1).

Independent claim 12 is illustrative:

> 12.   A method of previewing a document over a network, the method comprising:
>
>   providing system software for use on a client, wherein the system software allows a user of the client to use an application configured to at least one of: display or edit the document to request to remotely print the document, and, in response to the request and without user-initiated interaction with a server, generates a print file on the client based on the document, transmits the print file from the client to the server in response to the generation of the print file, and prompts the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file;
>
>   obtaining the print file from the system software executing on the client on the server; and
>
>   providing a configuration wizard for display in a browser on the client in response to a request from the client.

Rejections

1. Claim 41 stands rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,134,568 (Tonkin).

2. Claims 37, 38, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,615,234 B1 (Adamske).

3. Claims 12-16, 20-27, 31-36, 39, and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Adamske in view of Tonkin.

4. Claim 43 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Adamske, Tonkin, and Konica Minolta, "OMS Printing Notes for Windows Applications," published June 20, 1995 (KM).

Prior Decision

This application was the subject of previous Appeal No. 2007-003345, mailed June 18, 2008. (Examiner Affirmed).

ANALYSIS

We consider Appellants' arguments seriatim:

Claim 41 – rejected under § 102(e) over Tonkin

Appellants contend, *inter alia*, that "the Examiner fails to show that Tonkin discloses generating content for a display area that concurrently includes a preview area, a navigation area, an estimate area, and a configuration area as claimed therein." (App. Br. 9). In particular, Appellants aver that "the Examiner ignores express teachings of Tonkin that

indicate that the various windows *are presented in series, rather than concurrently*."

(App. Br. 10, emphasis added).

The Examiner disagrees:

> All of the elements discloses by the figures of Tonkin (specifically Figures 5, 8, and 9) are windows
> that exist as a part of the main graphical user interface (column 3, lines 15-31 of Tonkin). By definition windows are a part of a graphical user interface that encompass a portion of the screen that allow many different items to be displayed on the screen concurrently (see the definition of "window" provided from the Microsoft Press Computer Dictionary, published in 1993).
>
> . . .
>
> with regard to independent claim 41, *there is no specific requirement for the claimed areas to be "concurrently visible" but only that the display area "concurrently includes*." The Examiner notes that a reasonable interpretation/definition of the term "concurrently" is "acting in conjunction." In view of this, clearly the multiple displayed windows of the graphical user
> interface of Tonkin are included concur[r]ently with each other to provide the all of the claimed functionality.

(Ans. 20, emphasis added).

Issue - claim 41 (rejected under §102)

Does Tonkin disclose generating content for a display area that concurrently includes a preview area, a navigation area, an estimate area, and a configuration area, within the meaning of claim 41?

Analysis - claim 41 (rejected under §102)

At the outset, we observe that the Examiner maps the disputed preview, navigation, estimate, and configuration areas to multiple columns and different figures of Tonkin. (Ans. 4, 19-20).

We begin our analysis with claim construction. On this record, we conclude that the Examiner's interpretation of "concurrently" as "acting in conjunction [with]" is overly broad, unreasonable, and inconsistent with Appellants' Specification. We conclude that the plain meaning of the claim language "wherein the display area concurrently includes . . ." requires a single display area of the graphic user interface that includes each of the claimed preview, navigation, estimate, and configuration areas. These elements must be shown by the Examiner to establish anticipation.

As pointed out by Appellants, the Examiner has cited three distinct windows in Tonkin as purportedly disclosing the (single) display area of claim 41. (App. Br. 9, last paragraph; *see also* Ans. 19-20). While we agree with the Examiner that Figures 5, 8, 9 are windows that exist as part of Tonkin's main graphical interface (Ans. 19-20), the disparate windows of Tonkin are insufficient to established anticipation of the claimed "a graphical interface comprising . . . a display area . . . wherein the display area *concurrently includes* . . . a preview area, . . . a navigation area, . . . an estimate area, . . . and a configuration area." (Claim 41).[1]

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[1] *See Net MoneyIn, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (To anticipate under §102 "it is not enough that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings

Even if *arguendo* the portions of the various figures referenced by the Examiner (Figs 5, 8, and 9; Ans. 19) could be displayed concurrently within a single display area of a larger graphical user interface, "[i]nherency … may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, (Fed. Cir. 1999) (internal citations omitted).

Therefore, we reverse the Examiner's anticipation rejection of independent claim 41 for essentially the same reasons argued by Appellants in the Briefs.

Claim 37 – rejected under § 103(a) over Adamske

Appellants present multiple arguments urging the patentability of claim 37 over Adamske. (App. Br. 12-17). We focus our analysis on the last argument Appellants present regarding independent claim 37:

> In particular, in the [prior] decision [Appeal 2007-3345, decided June 18, 2008], the BPAI "broadly but reasonably construe[d] a 'client' as a requester of services and a 'server' as a provider of services." Decision on Appeal, p. 10. Additionally, the BPAI stated that "Adamske's conversion program 18 teaches and/or suggests 'system software,' as claimed." *Id.* As found by the BPAI, the conversion program is included on the application translation server of Adamske. Decision on Appeal, p. 7, Findings of Fact 3. To this extent, in the previous decision, the BPAI interpreted the application

that the artisan might somehow combine to achieve the claimed invention.")
(underline added).

translation server 24 of Adamske as allegedly corresponding to the client of the previously claimed invention.

Appellants' claim 37 includes several features that clearly differentiate the client described therein from the application translation server of Adamske. For example, the invention of claim 37 includes features indicating that the server: (a) obtains document information for a document from the system software executing *on the client;* (b) generates and transmits a unique identifier for use by the system software [executing *on the client*]; (b) obtains the print file from the system software executing *on the client;* (c) obtains a request for a configuration graphical user interface *from the client* subsequent to obtaining the print file; and (d) provides the configuration graphical user interface for display in a browser **on** *the client* in response to the request. To this extent, the server receives document information, a print file, and a request for a configuration graphical user interface from the same client, and provides the client with a unique identifier and the configuration graphical user interface for display in a browser thereon. In light of these features, Appellants respectfully submit that the invention of claim 37 includes additional aspects with respect to the interaction between the client and the server that clearly overcome the BPAI's previous interpretation of the application translation server 24 of both embodiments of Adamske as allegedly corresponding to a previously claimed client.
(App. Br. 16-17).

Issue - claim 37 (rejected under §103 over Adamske)

Would Adamske have taught or suggested the steps of the method performed in the claimed manner on a client and a server, and generating a

unique identifier for the *document on the server*, within the meaning of claim 37?

At the outset, we observe that claim 37 was added by amendment and was not before the previous panel which considered claims 12-33 in the form presented in previous Appeal 2007-003345.

Based upon our review of the record, we agree that Appellants' new claim 37 includes the specific features described above that serve to distinguish the claimed "client" from the application translation server 24 of Adamske (*See* Fig. 2).

We also find the Examiner has not fully developed the record to explain how the "created metafile" (Adamske, col. 6, l. 46) would have taught or suggested the claimed generated *unique identifier* for the *document on the server*, as Adamske's alternative embodiment pointed to by the Examiner (particularly col. 6, ll. 29-57) allows printing from a client-based application (i.e., a client-side document) via print driver program 14, which is shown as residing on client computer 11 (Adamske, Fig. 2; *see also* Ans. 21).

Therefore, we reverse the Examiner's rejection of claim 37 for essentially the same reasons argued by Appellants on pages 16-17 of the Brief. For the same reasons, we reverse the Examiner's obviousness rejection over Adamske for associated dependent claims 38 and 40.

We also reverse the Examiner's rejection of dependent claim 39 over Adamske and Tonkin because we agree with Appellants that the Examiner has not established that Tonkin cures the deficiencies of Adamske as discussed above regarding independent claim 37. (App. Br. 26).

*Representative Claim 12 – rejected under § 103(a)
over Adamske and Tonkin*

Regarding representative claim 12, we observe that Appellants recite the entirety of the "providing system software for use on a client" clause of claim 12, but ignore the "configured to *at least one of*:" language recited in the claim. We broadly but reasonably construe this "*at least one of*" language as requiring the Examiner show only one of the recited alternatives. Therefore, for essentially the same reasons argued by the Examiner, we agree that the proffered combination of Adamske and Tonkin would have taught or suggested "wherein the system software allows a user of the client to use an application configured to <u>*at least one of*</u>: display or edit the document to request to remotely print the document . . . ." (Claim 12, emphasis added). See Adamske's "print preview" feature described at col. 6, ll. 44 and 57. (Ans. 6-7).

Accordingly, we sustain the Examiner's rejection of representative claim 12. Because Appellants do not present separate arguments for associated dependent claims 15, 16, and 34, we sustain the Examiner's rejection of these claims for the same reasons discussed above regarding claim 12. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Dependent Claims 32 and 33

For convenience, we reproduce claims 32 and 33 here:

> 32. The method of claim 12, wherein the print file can be directly printed by a printer.

33. The method of claim 12, wherein the print file comprises one of: a PostScript file and a Portable Document Format (PDF) file.

Appellants' arguments notwithstanding (App. Br. 21-22), we agree with the Examiner that the subject matter of claims 32 and 33 would have been taught or suggested by the Adamske reference that teaches the print file can be directly printed to a printer in the form of a PostScript file (column 5, line 37). As pointed out by the Examiner, the Tokin reference also teaches a PDF file (column 7, lines 11-27: "PDF ... first convert them into a portable document format"). (Ans. 25). Therefore, we sustain the Examiner's rejection of claims 32 and 33 over the combination of Adamske and Tonkin.

Dependent Claims 13 and 14

Claim 13 recites: "The method of claim 12, wherein the providing system software step includes installing at least one print driver for *generating the print file on the client*." (emphasis added).

Claim 14 recites:

14. The method of claim 13, further comprising:

generating the print file on the client using one of the at least one print driver in response to the request;

transmitting the print file to the server over the network in response to the generating; and
prompting the user to configure and preview the bound copy of the document. (emphasis added).

Regarding claim 13, Appellants focus the dispute ("*generating the print file <u>on the client</u>*") on Adamske's application translation server which Appellants contend is not a client. (App. Br. 22).

Regarding claim 14, Appellants again contend that the print file is generated on Adamske's application translation server, instead of being generated on the client as claimed. (App. Br. 23). In particular, Appellants aver that "both embodiments of Adamske teach the generation of a print file on an application translation server (Adamske, col. 5, lines 21-24; col. 6, lines 50-52), even when a print driver program is present on the client computer (Adamske, col. 6, lines 34-38)." (App. Br. 23).

Adamske in pertinent part discloses:

> In the embodiment shown in FIG. 2, <u>the conversion program 18 is written as a Windows NT</u>^{TM} <u>service that uniformly converts every electronic document into a portable printable format</u>, regardless of the client application used to create the electronic document. In the embodiment described, the application translation server 24 executes conversion program 18 to open the user's electronic document using the appropriate client application and instructs the application to output the electronic document as an Adobe PostScript.TM. file. This PostScript file is then used for subsequent processing. Thus, <u>the conversion program 18</u> reads in the electronic document from the web server 22, determines the client application in which the document was created, opens this client application resident on the application translation server 24, <u>opens the electronic document using the client application, converts the electronic document into a printable (e.g., PostScript) format file</u>, and closes the converted electronic document

(col. 5, ll. 28-45, underline added).

We observe that Adamske teaches that "application translation server 24, opens the electronic document using the client application, converts the electronic document into a printable (e.g., Postscript) format file, and closes the converted electronic document." (Col. 5, ll. 42-45). In particular, Adamske teaches that "the conversion program 18 is written as a Windows NT^{TM} service that uniformly converts every electronic document into a portable printable format, regardless of the client application used to create the electronic document." (Col. 5, ll. 28-32, underline added). We observe that conversion program 18 is clearly shown as being resident on application translation server 24 in Adamske's Figure 2.

Thus, while we agree with the Examiner that the print driver is installed on the client and used to generate a metafile, i.e., a viewable representation of the hard copy document (Adamske, col. 6, ll. 44-54), we nevertheless find the weight of the evidence (Adamske, col. 5 as reproduced above) supports Appellants' contention that the proffered combination of Adamske and Tonkin does not teach or fairly suggest generating the print file (e.g., PostScript file) on the client as claimed. (Claim 14). For these reasons, we reverse the Examiner's § 103 rejection of claims 13 and 14.

Independent claim 20

Appellants present a single argument for claim 20: "Appellants respectfully submit that the proposed combination of the two embodiments of Adamske and Tonkin fails to teach or suggest a component configured to preview a document over a network by providing the system software claimed therein." (App. Br. 24).

The Examiner disagrees: "Appellant's arguments fail to comply with 37 CFR 1.111 (b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references." (Ans. 26).

We agree with the Examiner. *See Ex parte Belinne*, No. 2009-004693, 2009 WL 2477843 (BPAI Aug. 10, 2009) (informative). We also observe that Adamske clearly teaches a "print preview" feature. (Col. 6, ll. 37, 58).

Accordingly, we sustain the Examiner's obviousness rejection of independent claim 20 and dependent claims 21 and 23 (not argued separately) which fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Dependent Claim 22

Claim 22 recites:

22.   The system of claim 21, further comprising *a local application that generates the document*, displays the list of available printers and enables a user to select the print driver from the list of available printers.

Appellants contend that the recited "local application" has not been shown by the Examiner, and that "Adamske does not teach that the *print driver program generates a print file*, or is included as part of system software that communicates the print file to a server in response to the generation without user-initiated interaction with the server." (App. Br. 25, emphasis added).

Regarding the "local application," we conclude that the claim term "local" is a broad, relative term that does not specify what the application is "local" to. Moreover, the argued "print file" is not recited in claim 22. Therefore, we find Appellants arguments unpersuasive because they are not commensurate with the scope of claim 22. Accordingly, we sustain the Examiner's § 103 rejection of claim 22 over the combination of Adamske and Tonkin.

Independent claims 24, 31, and 42

Appellants present the following arguments:

> With respect to claim 24, for reasons that should be obvious in view of the discussion of the proposed combination of the two embodiments of Adamske and Tonkin above, Appellants respectfully submit that the proposed combination of the two embodiments of Adamske and Tonkin fails to teach or suggest a component configured to print a document over a network by providing the system software claimed therein.

(App. Br. 25).

> With respect to claim 31, for reasons that should be obvious in view of the discussion of the proposed combination of the two embodiments of Adamske and Tonkin above, Appellants respectfully submit that the proposed combination of the two embodiments of Adamske and Tonkin fails to teach or suggest program code for enabling a computer system to print a document by providing the system software claimed therein.

(App. Br. 26).

> With respect to claim 42, for reasons that should be obvious in view of the discussion of the proposed combination of the two embodiments of Adamske and

14

> Tonkin above, Appellants respectfully submit that the
> proposed combination of the two embodiments of
> Adamske and Tonkin fails to teach or suggest a computer
> program product for enabling a computer system to
> preview a document by generating a print file
> on a client, transmitting the print file from the client to a
> server without user-initiated interaction with the server,
> and prompting the user to configure and preview a bound
> copy of the document as claimed therein.

(App. Br. 26-27).

The Examiner disagrees: For each of independent claims 24, 31, and 42, the Examiner contends that "Appellant's arguments fail to comply with 37 CFR 1.111 (b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references." (Ans. 27-29).

We agree with the Examiner. Attorney arguments and conclusory statements that are unsupported by factual evidence are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); *see also Ex parte Belinne* No. 2009-004693, 2009 WL 2477843 (BPAI Aug. 10, 2009) (informative).

Accordingly, we sustain the Examiner's obviousness rejection of independent claims 24, 31, and 42, and associated claims 25-27, 35, and 36 (not argued separately) which depend from claim 24 and fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Dependent Claim 43

The Examiner rejected claim 43 under 35 U.S.C. § 103(a) as being unpatentable over combination of Adamske, Tonkin, and KM. (Ans. 17).

Appellants contest the rejection of claim 43 as follows:

> Appellants incorporate the arguments presented above with respect to claim 42 from which this claim depends. Additionally, Appellants submit that the proposed combination of the two embodiments of Adamske and Tonkin with KM fails to address the deficiencies of the proposed combination of the two embodiments of Adamske with Tonkin discussed above with respect to claim 42. As a result, Appellants respectfully request reversal of the rejection of claim 43.

(App. Br. 27).

On this record, Appellants have not established any deficiencies with Adamske and Tonkin regarding claim 42 from which claim 43 depends. See our discussion of claim 42 *supra*. Therefore, we are not persuaded of error regarding the Examiner's rejection of dependent claim 43. Accordingly, we sustain the Examiner's obviousness rejection of claim 43.

DECISION

We reverse the Examiner's decision rejecting claim 41 under § 102(e).

We reverse the Examiner's decision rejecting claims 13, 14, and 37-40 under § 103(a).

We affirm the Examiner's decision rejecting claims 12, 15, 16, 20-27, 31-36, 42, and 43 under § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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